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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,607	08/07/2006	Masahiko Itakura	2224-0258PUS1	9585

2292 7590 06/04/2009
BIRCH STEWART KOLASCH & BIRCH
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EXAMINER

JOY, DAVID J

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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06/04/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/588,607	Applicant(s) ITAKURA ET AL.	
	Examiner David J. Joy	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction – Lack of Unity

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted:
 - a. Group I, Claims 1-6, drawn to a laser-weldable resin label;
 - b. Group II, Claims 7 and 8, drawn to a laser-weldable resin label having a printed layer formed thereon;
 - c. Group III, Claims 9-11, drawn to a laser-weldable resin label having a laser-absorbing part formed thereon;
 - d. Group IV, Claim 12, drawn to a shaped composite article;
 - e. Group V, Claims 13-15, drawn to a shaped composite article having a laser-absorbing part formed thereon;
 - f. Group VI, Claim 16, drawn to a shaped composite article that is a toner

cartridge.

4. The inventions listed as Groups I – VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: As evidenced by the teachings of the prior art (specifically, the U.S. Patent Application Publication of Joachimi et al., US 2003/0130381), it is established that the special technical feature of the instant Claim 1, a laser-weldable resin label having the presently-claimed properties, is known in the art (see e.g., *Joachimi* at Abstract and ¶¶ [0024], [0025], [0032] and [0033]). Therefore, there is lack of unity *a posteriori*, since the special technical feature of Claim 1 is not a technical feature that defines a contribution over the prior art.

5. It is also noted that there are significant differences between the groups. Group I broadly claims the laser-weldable resin label. Group II requires that there be a printed layer formed on the surface of the label, and this limitation is not required of any of the other label groups. Group III requires that there be a laser-absorbing part formed on the surface of the label, which is a limitation that not required of any of the other label groups. Groups IV – VI are all drawn to a shaped composite article (which is a patentably distinct invention, in and of itself), and these groups also possess significant

differences. While Group IV broadly claims a shaped composite article, Group V adds the requirement that the article have a laser-absorbing part formed on a surface thereof, while Group IV is explicitly drawn to a composite article that is a toner cartridge. Nevertheless, these are significant limitations that are not all required by each of the groups claimed therein.

6. In light of the complexity of the restriction requirement for this application, no telephone communication regarding the restriction has been made. See MPEP §812.01.

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

8. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin M. Bernatz, acting SPE for Carol D. Chaney, can be reached on (571) 272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/

Examiner, Art Unit 1794

05/29/2009

/Bruce H Hess/

Primary Examiner, Art Unit 1794